

Remarks:

Applicant has carefully studied the final Examiner's Action mailed 25 July 2008, and all references cited therein. The amendments appearing above and these explanatory remarks are believed to be fully responsive to the Office Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Status of the Claims

Claims 1-17 were pending and under examination in the Office Action dated 25 July 2008.

Claims 1 and 16 have been amended to recite "associating the claim identifier with the payment number using a processor..." Support for this amendment can be found paras. [0032]-[0033] and FIG. 3.

New claims 18-21 are presented in the response. Claims 18 and 20 recite that claim identifier uniquely identifies the received claim request. Support for these claims can be found in para. [0030] of the original specification. Claims 19 and 21 recite that the claim identifier is generated by the administrator of the claim. Support for these claims can be found in para. [0033] of the original specification in conjunction with FIG. 4.

Claims 1 and 16 have been further amended to recite "by an administrator" in the preamble to the claims thereby providing antecedent basis for "the administrator" recited in new claims 19 and 21. Support for this term can be found in paras. [0030] and [0033], as well as elsewhere in the original specification.

No other claims are amended, canceled or withdrawn in the instant response. Therefore, claims 1-21 are currently pending and under examination.

Claim Rejections – 35 U.S.C. § 101

Applicant acknowledges the quotation of 35 U.S.C § 101.

Statutory Subject Matter

Claims 1-17 stand rejected as allegedly directed towards non-statutory subject matter.

In making the rejection the Office cites Supreme Court and “recent” Federal Circuit decisions for support of the proposition that a “§101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing ...”¹

With respect to the claims of the instant application the Office has asserted that “regarding the first test, in performing the steps of the claimed subject matter, there is no requirement [in the claims] that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory.” The Office further asserts that “to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied. The Office then provides an example of claim language that would satisfy 35 USC §101.

The Office indicates that “a method claim that is sufficiently tied to another statutory class (i.e., product) would be recited as follow: authorizing, via a processor, the predetermined limit amount.”

Applicant thanks the Office for their suggestion and adopts the suggestion to the extent practicable within the scope of the currently pending claims. It is noted that the phrase “authorizing the predetermined limit amount...”, as suggested in the example above, is found only in dependent claim 6. Consequently, adoption of the suggested phraseology would not be applicable to claims 1-5 or 7-17. Therefore, claims independent claims 1 and 16 have been amended using language as suggested by the Office. In particular, claims 1 and 16 have been amended to recite “associating the claim identifier with the selected payment number using a processor ...”

As indicated in the Office Action on page 2, numerous Federal Circuit decisions have addressed the issue of statutory subject matter. Among the Federal Circuit decisions more recent than those cited by the Office was *State Street Bank & Trust Co. v. Signature Financial Group, Inc* 149 F.3d 1368, 1371 (C.A.Fed. (Mass.), 1998). The Court in *State Street* concluded that,

¹ Office Action dated 25 July 2008 at page 2.

“[W]e hold that the transformation of data ... by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm.”² The court in *In re Comiskey* elaborated on this statement. There, the Court stated:

When an unpatentable mental process is combined with a machine, the combination may produce patentable subject matter, as the Supreme Court's decision in *Diehr* and our own decisions in *State Street Bank* and *AT & T* have confirmed. See *Diehr*, 450 U.S. at 178-79, 192-93, 101 S.Ct. 1048 (holding patentable a process for curing rubber that used a mathematical algorithm to determine when to open the molding press); *AT & T*, 172 F.3d at 1355, 1361 (holding patentable a method for determining whether long-distance calls were being made between long-distance carriers or within a single long-distance carrier that used a mathematical algorithm and “require[d] the use of switches and computers”); *State Street Bank*, 149 F.3d at 1371 (holding patentable a “system that allows an administrator to monitor and record the financial information flow and make all calculations necessary for maintaining a partner fund financial services configuration” where a “computer or equivalent device [wa]s a virtual necessity to perform the task.”). While the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter, see *In re Grams*, 888 F.2d 835, 839-840 (Fed.Cir.1989), these claims in combining the use of machines with a mental process, claim patentable subject matter.³

Thus, according to the Court, the recitation of a machine, when combined with a mental process, places the invention squarely within the realm of patentable subject matter. The Court further held that claims which, under the broadest reasonable interpretation, could require the use of a computer as part of the claimed subject matter, claimed patentable subject matter.⁴ Thus, as in *State Street* referred to in the excerpt above, where a computer would be a virtual necessity to perform the task, the task is taken out of the realm of a mental process.⁵

Claim 1, as amended, is directed to “[a] method of paying a merchant by an administrator for a claim service provided to a claimant, the method comprising the steps of ... associating the claim identifier with the payment number using a processor; ...” The claimed method is therefore tied to another class of statutory subject matter; namely a machine. Claims 2-15 and 18-19 are dependent upon claim 1 and would therefore include all of its limitations, rendering them allowable as a matter of law based upon dependency to an allowable base claim with regard to the statutory requirement at issue.

Independent claim 16 similarly recites “[a] method of paying a merchant by an administrator for a claim service provided to a claimant, the method comprising the steps of ...

² Office Action dated 25 April 2008 at page 5 citing *State Street Bank*, 149 F.3d at 1373.

³ *In re Comiskey* 499 F.3d 1365, 1379 -1380 (C.A.Fed.,2007).

⁴ *In re Comiskey* 499 F.3d 1365 , 1379 (C.A.Fed.,2007).

⁵ “Given the complexity of the calculations, a computer or equivalent device is a virtual necessity to perform the task.” *State Street Bank & Trust Co. v. Signature Financial Group, Inc* 149 F.3d 1368, 1371 (C.A.Fed. (Mass.),1998).

associating the claim identifier with the selected payment number using a processor; ...” and is also tied to another class of statutory subject matter; namely a machine (i.e. a computer/processor). Claims 17 and 20-21 are dependent upon claim 16 and would include all of its limitations. By the recitation of “using a processor...” it is meant that at least the recited step employs a processor. However, all of the steps need not be computer-implemented. For example, and not by way of limitation, the step of “receiving a request from a merchant for a payment associated with a claim ...” as in claim 1 may involve a processor/computer, but need not require it.

Based upon the foregoing, and in light of Applicant’s amendment of the claims, it is submitted that claims 1-21 are directed towards statutory subject matter. It is therefore respectfully requested that the Office withdraw the rejection of claims 1-17 under 35 U.S.C. 101.

Claim Rejections – 35 U.S.C. § 102

Applicant acknowledges the quotation of 35 U.S.C § 102(e).

Claims 1-17 stand rejected by the Office as allegedly anticipated under 35 U.S.C § 102(e) by U.S. Patent No. 6,901,387 B2 to Wells et al. (“Wells”). Applicant traverses this rejection because the Wells patent fails to teach each element of the claim under consideration. ***Generally speaking***, Wells teaches a system that relies heavily on interaction between a client/claimant and an issuer, with some *limited* involvement by the merchant in the system. In contrast, the present invention teaches ***and claims*** a system based almost exclusively on merchant/issuer(administrator) interaction with little or no involvement of the client/claimant. Note that the discussion below is based, in part, upon arguments made by Applicant in Applicant’s Amendment A, though the arguments have been elaborated upon responsive to assertions made by the Office in the latest Office Action.

It is well settled that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.”^{6,7} To find anticipation the identical invention

⁶ W.L. Gore and Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing Soundscriber Corp. v. United States, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984); See also Carella v. Starlight Archery, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir.), modified on reh’g., 1 USPQ 2d 1209 (Fed. Cir. 1986). RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

⁷ See also MPEP 2131 providing “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of*

must be shown in as complete detail as is contained in the claim with the elements arranged as required by the claim.⁸ For a rejection under 35 U.S.C. 102 to be proper, the cited reference must clearly and unequivocally disclose the claimed subject matter; a rejection may not be made by picking and choosing among different options or elements from various portions of the specification or as found in different embodiments to produce the claimed invention for the purpose of a rejection for anticipation.^{9,10}

“The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103.”¹¹ It is submitted that an express disclosure of subject matter corresponding to a limitation would be one where the subject matter is explicitly stated and would be capable of pinpoint citation in support of a rejection by the Office, with little or no explanation in support of the pinpoint citation (i.e. the cited section would essentially be self-explanatory). Where the disclosure is implicit or inherent, additional support must be made in support of a rejection and additional requirements must be addressed. In particular, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”¹² “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”^{13, 14} Probabilities or possibilities are not sufficient.

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

⁸ *Id.*

⁹ “When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Akzo N.V. v. International Trade Commission*, 808 F.2d 1471, 1480 (Fed. Cir. 1986), cert. denied, 107 S. Ct. 2490 (1987); *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972).” *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q.2d (BNA) 1913, 1928, 1988 WL 188449 (E.D. Tenn. 1988), *judgment aff'd*, 887 F.2d 1094, 13 U.S.P.Q.2d (BNA) 1956 (Fed. Cir. 1989)

¹⁰ “[F]or the instant rejection under 35 U.S.C. § 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.” *Application of Arkley* 59 C.C.P.A. 804, 807, 455 F.2d 586, 587 - 588 (Cust. & Pat.App.1972).

¹¹ See MPEP 2112 – Requirements of Rejection Based on Inherency – Burden of Proof.

¹² See MPEP 2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

¹³ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

For the purposes of contrasting Applicant's invention with the teachings of the Wells' patent, certain designations/characterizations will be made to facilitate the discussion. Designations for the purposes of facilitating a meaningful discussion should not be construed as a limitation to the present claims. In particular, for the purposes of contrasting the differences, Applicant will refer to the systems, both as taught in Wells' and in Applicant's invention, as three party systems. Reference to figure 1 of the Wells patent is illustrative. Both systems make reference to a merchant, so the application of this term is straightforward. A second party to the transaction is Applicant's "claimant" (e.g. as in the preamble to claim 1), which would be roughly analogous to the "client" of Wells. This party will be referred to in the following discussion as "claimant/client" or "client/claimant". Lastly, there is a third party that Wells refers to as the "issuer". This party will be referred to as the "issuer/facilitator/administrator" or "administrator/facilitator/issuer" in deference to Wells designation of the party as the issuer. Note that numerous portions of Applicant's text refer to an "administrator" (e.g. para [0033], second sentence).

Claim 1 of the present invention is directed at "[a] method of paying a merchant by an administrator for a claim service provided to a claimant ..." This recitation makes clear that there is an administrator/facilitator (i.e. issuer/facilitator/administrator) administrating the paying/payment to the merchant (which has further been made explicit in the preamble to the claims). The method includes the steps of receiving a request from a merchant for a payment associated with a claim (i.e. the administrator receives the request), generating a claim identifier, generating a payment number having a predetermined limit amount and a predetermined expiration date, associating the claim identifier with the payment number and transmitting the payment number to the merchant for payment of the claim. The steps of the preceding transaction are steps occurring either (1) between the merchant and the administrator/issuer/facilitator or (2) at the administrator/issuer/facilitator. For example, the method includes the step of "generating a claim identifier..." Implicit in this recitation is that the claim identifier is generated by the administrator/issuer/facilitator. Importantly, the step of generating the claim identifier clearly does not involve the claimant/client. The other

¹⁴ See also MPEP 2112 - Requirements of Rejection Based on Inherency; Burden of Proof - "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may

independent, claim 17, is similarly directed with respect to the remarks made above. In particular, the claim implicates steps taken by the issuer/facilitator or interactions between the issuer/facilitator and the merchant.

Wells teaches an electronic purchasing transaction system. In making the rejection over the Wells patent the Office has made specific reference to the embodiment outlined in FIG. 7 of Wells and stated that “receiving a request from a merchant for a payment associated with a claim (see fig.7 element 702, i.e., selection of merchant and item to be purchase is inherently followed by a request from a merchant for a payment)”

Furthermore, in making the rejection the Office has stated that “Wells discloses ... generating a claim identifier (see fig. 7 element 704)...”¹⁵ Thus, according to the Office, element 704, Wells’ “purchase order”¹⁶ is analogous to Applicant’s “claim identifier”. Wells describes the process embodied in FIG. 7 as detailed in columns 17-21 of the Wells patent. According to Wells:

The process begins at step **702** when a participant in a purchasing program (a “client” or its agent) selects a merchant and one or more items to be purchased from the merchant. ... The client (or the purchasing system software or accounting software used by the client) then assigns a purchase order identifier to the desired transaction (step **704**). In the example transaction, the purchase order identifier is automatically generated (e.g., from the company's procurement system).¹⁷

Therefore, according to Wells, it is the client who begins the process. In beginning the process, the client generates the purchase order/claim identifier. In the system taught and claimed by Applicant, the client/claimant plays no part in generating the claim identifier. Up to this point in Wells, only the client has been involved. In the system claimed by Applicant it both the merchant and the issuer/facilitator are involved (e.g. see the step of “receiving a request from the merchant for a payment associated with a claim” followed by “generating a claim identifier”). Contact with the other parties in Wells begins when “Processing continues at **705** where the client (e.g., by operating a client device such as shown in FIG. 1) submits the purchase order information to account management system **105**.¹⁸ Wells describes the steps that follow between the client/claimant and the issuer/facilitator as follows:

not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

¹⁵ Office Action mail dated March 13, 2008 at page 2; Office Action mail dated July 25, 2008 at page 3.

¹⁶ See U.S. Patent No. 6,901,387 B2 to Wells et. Al, at col. 18, lines 2-3.

¹⁷ U.S. Patent No. 6,901,387 B2 to Wells et. Al, at col. 17, line 60 through column 18, line 6.

¹⁸ U.S. Patent No. 6,901,387 B2 to Wells et. Al, column 18, line 6.

Processing continues at 706 where account management system 105 operates to authenticate the identity of the client submitting the request. ... Processing continues at 707 where a pre-authorization request is submitted from account management system 105 to the issuer processor (or, in some embodiments, to the account issuer). ... The pre-authorization request includes the limited use account identifier selected at 706 and information from the purchase order (e.g., such as the total purchase amount of the proposed transaction). ... In response to the pre-authorization request, the issuer processor returns a pre-authorization response to account management system 105. If the pre-authorization response is a confirmation that a pre-authorization for a particular amount has been set up, processing continues at 708 where account management system 105 forwards the selected limited use account identifier to the client. The client may then utilize the limited use account identifier in the subject transaction.¹⁹

Up to this point the merchant has not been involved in the method taught by Wells. The transaction has proceeded through interaction between the client/claimant and the issuer/facilitator.

“transmitting the payment number to the merchant for payment of the claim” as claimed is not met by transmitting limited use account identifier to the client

The Office has characterized the step of “transmitting the payment number to the merchant for payment of the claim” as in independent claims 1 and 16 as being met by step 712 of FIG. 7. More specifically, the Office states:

Re claim 1. Wells discloses a method of paying a merchant for a claim service provided to a claimant, the method comprising the steps of: ... transmitting the payment number to the merchant for payment of the claim (see fig.7 element 712).²⁰

To parse the phrase in the claims at issue: (1) there is a transmittal (2) *of the payment number* (3) **to the merchant** (4) for payment of the claim. Implicit in the phrase is that there must be another party making the transmittal to the merchant. That implicit party in the claim would be the administrator/issuer/facilitator. This has been made more explicit by the amendment to the preamble reciting the administrator.

Step 712 of FIG 7 states “TRANSMIT LIMITED USE ACCOUNT IDENTIFIER TO CLIENT FOR PRESENTATION TO MERCHANT”. Thus, if one assumes for the purpose of argument that the limited use account identifier is analogous to the payment number, then the phrase becomes “TRANSMIT PAYMENT NUMBER TO CLIENT FOR PRESENTATION TO MERCHANT”. However, the claim calls for the payment number to be transmitted to the merchant, not to the client. The transmittal would also not be by the client to the merchant, but

¹⁹ U.S. Patent No. 6,901,387 B2 to Wells et. Al, column 18, line 18 through column 19, line 11.

²⁰ Office Action mail dated July 25, 2008 at page 3.

rather from the administrator to the merchant. And the further act of presenting by the client to the merchant does not constitute *transmittal* to the merchant [by the administrator].

Simply put, to the extent that reference is made to FIG. 7 of Wells, those steps must be followed through their logical order in making an assertion of anticipation. Additionally, recognition must be made of those parties that are logically performing the steps. The Office would have the final step of Applicant's claim, namely "transmitting the payment number to the merchant for payment of the claim", as being met by step 712 of FIG. 7. However, the PAYMENT REQUEST TO ISSUER of Wells is not made until later in step 719, whereas in Applicant's claims "receiving a request from a merchant for a payment associated with a claim..." is the first step of the claim. Clearly the order of steps is drastically different. And this is just one instance of a discrepancy. The Office is reminded that to find anticipation the identical invention must be shown in as complete detail as is contained in the claim with the elements arranged as required by the claim.²¹ For a rejection under 35 U.S.C. 102 to be proper, the cited reference must clearly and unequivocally disclose the claimed subject matter; a rejection may not be made by picking and choosing among different options or elements from various portions of the specification or as found in different embodiments to produce the claimed invention for the purpose of a rejection for anticipation.^{22,23}

²¹ *W.L. Gore and Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984); See also *Carella v. Starlight Archery*, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir.), modified on reh'g., 1 USPQ 2d 1209 (Fed. Cir. 1986). *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).; See also **MPEP 2131** providing "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

²² "When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Akzo N.V. v. International Trade Commission*, 808 F.2d 1471, 1480 (Fed. Cir. 1986), *cert. denied*, 107 S. Ct. 2490 (1987); *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972)." *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q.2d (BNA) 1913, 1928, 1988 WL 188449 (E.D. Tenn. 1988), *judgment aff'd*, 887 F.2d 1094, 13 U.S.P.Q.2d (BNA) 1956 (Fed. Cir. 1989)

²³ "[F]or the instant rejection under 35 U.S.C. § 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making

Based upon the foregoing it is submitted that the Office has not established that Wells “disclos[es] in a single prior art reference of each element of the claim under consideration.”^{24, 25}

A purchase order is not a claim or a claim identifier

Independent claim 1 recites the limitations of “receiving a request from a merchant for a payment associated with a claim...” and “generating a claim identifier...” Independent claim 16 includes similar limitations.

The Office asserts that “Wells discloses ... generating a claim identifier (see fig. 7 element 704)...”²⁶

Element 704 of the flowchart of FIG. 7 of Wells states “ASSIGN PURCHASE ORDER CODE OR CHARACTER STRING”. Thus, according to the Office a purchase order is analogous to a claim and element 704 of Wells’ (i.e. the “purchase order code”²⁷) is analogous to Applicant’s “claim identifier”.²⁸ In fact, the Office explicitly states this on page 8 of the latest Office Action.

Applicant respectfully disagrees. More particularly, Applicant states that the purchase order code or character string of Wells element 704 does not constitute a teaching of a claim identifier, and therefore the Office has failed to establish a *prima facie* case of anticipation because the Office has not shown that all elements of the claim as recited are found in the reference cited, either implicitly or inherently.

of a 102, anticipation rejection.” Application of Arkley 59 C.C.P.A. 804, 807, 455 F.2d 586, 587 - 588 (Cust. & Pat.App.1972).

²⁴ W.L. Gore and Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing Soundscriber Corp. v. United States, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984); See also Carella v. Starlight Archery, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir.), modified on reh’g., 1 USPQ 2d 1209 (Fed. Cir. 1986). RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

²⁵ See also MPEP 2131 providing “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimum verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

²⁶ Office Action mail dated March 13, 2008 at page 2; Office Action mail dated July 25, 2008 at page 3.

²⁷ See U.S. Patent No. 6,901,387 B2 to Wells et. Al, at col. 18, lines 2-3.

²⁸ The Office states on page 8 of the Office Action dated July 25, 2008 that “contrary to the applicant’s assertion, Wells discloses generating a purchase order (see fig.7 element 704) which is akin to the claim number mentioned by the applicant.”

A purchase order is a request for an item whereby a contract arises through the acceptance of the purchase order by the merchant. A purchase order is generated by a buyer (client/claimant) and transmitted to a seller (merchant) in a transaction for the purchase of goods. The recipient (merchant) of a purchase order is under no legal obligation to accept the purchase orders terms and consummate the transaction. Wikipedia describes a P.O. as follows:

A purchase order (PO) is a commercial document issued by a buyer to a seller, indicating the type, quantities and agreed prices for products or services the seller will provide to the buyer. *Sending a PO to a supplier constitutes a legal offer to buy products or services. Acceptance of a PO by a seller usually forms a once-off contract between the buyer and seller so no contract exists until the PO is accepted.* POs usually specify terms of payment, incoterms for liability and freight responsibility, and required delivery date.²⁹ (emphasis added)

With respect to the structure and function of a PO, Wikipedia states as follows:

A purchase order usually contains: PO number, shipping date, billing address, shipping address, terms of payment (usually in the form of NET 30, NET 45 and NET 60 depending on requirements set by the seller), and a list of services/products, often including specifications and reference or part numbers of the items to be purchased, with quantities and prices. When accepted by the seller, it forms an agreement between the buyer and seller.

There are several reasons why companies use POs. They allow buyers to clearly and explicitly communicate their intentions to sellers, and to protect the seller in the event of a buyer's refusal to pay for goods or services. ... This document represents the buyer's intent to purchase specific quantities of product at specified prices. In the event of non-payment, the seller can use the PO as a legal document in a court of law to demonstrate the buyer's intent and to facilitate collection efforts. Companies usually request POs when doing business with other companies for orders of significant size, as the PO reduces the risks involved.

In the course of the accounts payable process, purchase orders are matched with invoices and packing slips before the invoices are paid.³⁰

Applicant's independent claims 1 and 16 do not recite the term "purchase order", nor do they recite a similar term. Instead, they recite "receiving a request from a merchant for a payment associated with a claim..." and "generating a claim identifier..."

A claim is a very different matter from a purchase order. The claims at issue explicitly recite the term "claim", and this term is therefore a part of the claims' limitations. A claim arises based upon a pre-existing contractual obligation (or some other asserted legal obligation) between the parties. A claim represents a legal right (or asserted legal right) vesting in the claimant that is presented to another party for satisfaction. That other party can be directly

²⁹ As accessed under the heading/terms "purchase order" at http://en.wikipedia.org/wiki/Purchase_order on Friday, September 26, 2008 at 11 A.M. EST.

³⁰ As accessed under the heading/terms "purchase order" at http://en.wikipedia.org/wiki/Purchase_order on Friday, September 26, 2008 at 11 A.M. EST.

responsible for satisfying the claim or a third party acting as some form of guarantor. Wordnet 3.0 defines a “claim” as “an assertion of a right (as to money or property).” The American Heritage Dictionary defines a “claim” as “[a] demand for something as rightful or due; [a] demand for payment in accordance with an insurance policy or other formal arrangement.” In paragraph [0030] Applicant describes the claim identifier, instructing that “[t]he claim identifier may consist of a plurality of elements, including the claim number, contract number, merchant information, claims adjustor number or any information that would be effective in identifying the claim.” Read in the context of the specification, it is the administrator who needs to be able to effectively identify a claim. Furthermore, the specification addresses scenarios under which claims would be presented, such as with insurance companies or as would be associated with the warranty service of an automobile.

With a purchase order system, the PO numbers are generated by the buyer without regard to whether they represent unique identifiers to the recipient of the PO. Usually, PO numbers issue sequentially from the purchaser. A consequence of this is that the PO numbers from two different purchasers could be the same to the recipient of the PO, which would not make them very useful for identifying a claim (absent some manipulation by the recipient).

The Office has asserted that “Wells discloses … generating a claim identifier (see fig. 7 element 704)…” Wells discloses generating a purchase order code *by the client*. A purchase order code is a number associated with a purchase order and therefore is a term recognized by the art to be generated by the client and presented with the offer to buy goods from the merchant. In contrast, the claims at issue recite “generating a claim identifier…” A claim identifier is an identifier that identifies a claim.³¹

Claims 19 and 21 further depend upon claims 1 and 16, respectively, and recite that the “claim identifier is generated by the administrator of the claim.” Clearly, a purchase order code

³¹ MPEP 2111.01 Plain Meaning - “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, *>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (“In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.”). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the “ordinary” and the “customary” meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003)

would not be generated by the administrator/issuer/facilitator as evidenced by the common usage of the term purchase order in the art. Additionally, Claims 18 and 20 further depend upon claims 1 and 16, respectively, and recite that the “claim identifier uniquely identifies the received claim request.” As above, purchase order as the term is commonly understood would not necessarily include a PO number that would uniquely identify the *received* claim (*received* purchase order; i.e. the term “received” implicates the recipient and not the issuer with regard to the “unique” status).

Based upon the foregoing it is further submitted that the Office has not established that Wells “disclos[es] in a single prior art reference of each element of the claim under consideration.”^{32, 33}

Selecting a merchant and item to be purchased is not inherently followed by a request for payment

The Office has further asserted that the step of “receiving a request from a merchant for a payment associated with a claim...” is inherently met by Wells.³⁴

As discussed above, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”³⁵

³⁶ Probabilities or possibilities are not sufficient.

³² W.L. Gore and Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984); See also *Carella v. Starlight Archery*, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir.), modified on reh’g., 1 USPQ 2d 1209 (Fed. Cir. 1986). *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

³³ See also MPEP 2131 providing “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

³⁴ Office Action mail dated July 25, 2008 at page 3.

³⁵ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

³⁶ See also MPEP 2112 - Requirements of Rejection Based on Inherency; Burden of Proof - "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

To make the case for inherency the Office asserts:

Re claim 1. Wells discloses a method of paying a merchant for a claim service provided to a claimant, the method comprising the steps of: receiving a request from a merchant for a payment associated with a claim (see fig.7 element 702, i.e., selection of merchant and item to be purchase is inherently followed by a request from a merchant for a payment)...³⁷

Thus, according to the Office, once the client selects a merchant and an item to be purchased (as in FIG. 7, element 702), it necessarily follows that the merchant will request payment. On the other hand, if it is possible that the client could select a merchant and an item to be purchased (as in FIG. 7, element 702), and such action is not followed by a payment request by the merchant, then the element would not be inherent.

In the scenario presented by FIG. 7, the client selects the merchant and item to be purchased in step 702. At step 707 the client gets pre-authorization. Presumably, the transaction could fail at this point. More importantly, the merchant submits the transaction for authorization at element 714. In element 716 the transaction is approved or not approved. If the transaction is not approved then the system declines the transaction. The result of this is that the “payment request from a merchant for a payment associated with a claim” as required by Applicant’s claim never reaches element 719 wherein there is “PAYMENT REQUEST TO ISSUER.” Therefore, selection of merchant and item to be purchase *is not inherently* followed by a request from a merchant for a payment. Based upon the foregoing it is further submitted that the Office has not established that Wells “disclos[es] in a single prior art reference of each element of the claim under consideration.”^{38, 39}

Wells also does not anticipate the subject matter of the dependent claims

Claims 2-4:

³⁷ Office Action mail dated July 25, 2008 at page 3.

³⁸ W.L. Gore and Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing Soundscriber Corp. v. United States, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984); See also Carella v. Starlight Archery, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir.), modified on reh’g., 1 USPQ 2d 1209 (Fed. Cir. 1986). RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

³⁹ See also MPEP 2131 providing “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ...The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d

Claim 2 recites the limitation that “the claim is for a service rendered.” Claim 3 recites the limitation that “the claim is for a replacement product received.” Claim 4 further limits the receiving step of claim 1 by reciting that the step further comprises “receiving an estimated cost of repair from the merchant.” The Office appears to address these claims on the second to last paragraph of page 2 where the paragraph begins “Re claims 1, 2-4. Wells discloses a method of paying a merchant for a claim service ...” However, the paragraph does not appear to address the limitations recited in the claims, nor do the sections cited by the Office with respect to claim 1 anticipate the subject matter of claims 2-4.

In the latest Office Action the Office states: “Wells further discloses the method of claim 1, wherein the claim is for a service rendered (i.e., sale transaction - purchase and delivery, see fig.7”

Claim 2 recites that “the claim is for a service rendered.” On the other hand, purchase orders, as discussed above, are for goods, not services. No part of FIG. 7 says anything about services rendered.

Claim 3 recites that “the claim is for a *replacement* product received.” (emphasis added) In the case of warranty or insurance contracts, both services rendered in replacing or repairing a damaged or defective item, and replacement of the defective item are significant facets of the transaction. Thus, these are not throwaway limitations within the context of the claims at issue. The Office has provided no indication that the method outlined in FIG. 7 meets these limitations.

Claim 4 recites that “receiving a request from a merchant for a payment associated with a claim further comprises, receiving an estimated cost of repair from the merchant.”

In response, the Office states “the examiner contends that estimated cost of repair would inherently be included in the purchase order that need to be settled by the client, see fig.7 elements 704-707 of Wells. Wells further discloses authorizing the predetermined limit amount (i.e., transaction amount authorization, see col. 3 line 56col. 4line 10).”⁴⁰

As discussed above, where the disclosure is implicit or inherent, additional support must be made in support of a rejection and additional requirements must be addressed. In particular,

1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

“[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”⁴¹ “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”^{42, 43} Probabilities or possibilities are not sufficient.

According to the Office, a purchase order **must necessarily** include an estimated cost of repair. Applicant submits that this assertion is contrary to the practices of those in the art. A purchase order is an order for the purchase of goods. Applicant requests the basis in fact for the Office’s assertion that purchase orders **must necessarily** include an estimated cost of repair. Alternatively, Applicant requests that the Office withdraw the rejection of the claim.

The Office further asserts that “Wells further discloses authorizing the predetermined limit amount (i.e., transaction amount authorization, see col. 3 line 56col. 4line 10)” However, the claim recited “an estimated cost of repair *from the merchant...*” An estimated cost of repair is not a transaction amount authorization as asserted by the Office, nor is the transaction amount authorization issueing from the merchant as required by the claim.

Claim 6:

The Office has not addressed the following traversal from the prior Amendment A in the Office Action dated July 25, 2008. Therefore it is repeated below:

With respect to claim 6 the Office has stated “Re claim 6. Wells further discloses the method of claim 1, wherein generating a payment number having a predetermined limit amount and a predetermined expiration date further comprises: receiving an estimated cost of repair from the merchant; and authorizing the predetermined limit amount (i.e., authorization see col. 4 lines 1-15)”

⁴⁰ Office Action mail dated July 25, 2008 at pages 7-8.

⁴¹ See MPEP 2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

⁴² *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

⁴³ See also MPEP 2112 - Requirements of Rejection Based on Inherency; Burden of Proof - "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Claim 6 further limits the “generating a payment number ...” step of claim one by reciting that steps of “receiving an estimated cost of repair from the merchant; and authorizing the predetermined limit amount.” Column 4, lines 1-15 of Wells is presented below:

If such data match, the transaction may be approved by the account issuer. After authorization of the transaction, the account issuer generates an account summary including the received financial amount and the purchase order number or other identifier received with the request. The account summary may be transmitted to the client for internal reconciliation. Pursuant to some embodiments, limited use account identifiers may be reissued or reused after a transaction using the limited use account identifier has settled or after a preauthorization of the limited use account identifier has expired.

In further embodiments of the disclosed system, the pool of available limited use account identifiers may be assigned prior to any purchase requests by an client, and the number of available limited use account identifiers may be based on the client's purchasing history, or other anticipated amounts of transactions by the client.

With all due respect, the excerpted passage does not teach anything about “receiving an estimated cost of repair from the merchant; and authorizing the predetermined limit amount.” The passage speaks of an account summary that may be provided by the issuer to a client for the purposes of reconciliation, but nothing is provided to the merchant nor does it implicate “receiving an estimated cost of repair from the merchant; and authorizing the predetermined limit amount.” In light of the foregoing it is respectfully submitted that Wells fails to teach each element of the claim under consideration.

Claim 7:

As indicated above, the Office has equated the “purchase order” of Wells with the “claim identifier” of the present invention (i.e. “Wells discloses ... generating a claim identifier (see fig. 7 element 704)...”⁴⁴). The claim at issue recites:

The method of claim 1, wherein generating the claim identifier further comprises:

identifying a contract number assigned to a claimant;

generating a claim number; and

associating the claim number with the contract number.

⁴⁴ Office Action mail dated March 13, 2008 at page 2.

Thus, the Office is stating, in essence, that: wherein generating the *purchase order* further comprises: identifying a contract number assigned to a claimant; generating a claim number; and associating the claim number with the contract number.”

The Office states “Re claim 7. Wells further discloses the method of claim 1, wherein generating the claim identifier further comprises; identifying a contract number assigned to a claimant; generating a claim number; and associating the claim number with the contract number (see fig.9)” Figure 9 of Wells references the Account Summary. The Office’s attention is respectfully addressed back to FIG. 7. In FIG. 7 at step 704 the purchase order is generated. At step 720 the account summary is generated. Clearly the two are very different steps occurring at very different times in the process. There is no indication that either meets the limitations of the claim. In light of the foregoing it is respectfully submitted that Wells fails to teach each element of the claim under consideration.

On page 8 of the latest Office Action, the Office reiterates: “[T]he account summary shown in fig.9 of Wells clearly shows how these generated purchase order (claim number) are associated with the contract number (please see fig.9 of Wells).”

As indicated above, the claim recites the limitation of a contract number. Applicant requests clarification as to which item in Fig. 9 of Wells is considered by the Office to be a contract number. As a preemptive point, Applicant would point out that the recitation of “contract number” necessarily implicates a contract. A master account number such as used to identify a customer would not necessarily implicate a contract. Therefore, the two are not the same. One can have customers without having contracts with one’s customer.

Claims 8 and 9:

Claim 8 recites:

The method of claim 1, further comprising after transmitting the payment number to the merchant for payment of the claim:

tracking at least one merchant payment associated with the payment number; and

associating the payment number and the claim identifier with the at least one merchant payment.

The Office states “Re claim 8. Wells further discloses the method of claim 1, further comprising after transmitting the payment number to the merchant for payment of the claim: tracking at least one merchant payment associated with the payment number; and associating the payment number and the claim identifier with the at least one merchant payment (see fig.9, also see col.13 lines 6-11)”

Figure 9 is an account summary, which, as indicated above with respect to claim 6, is for the client and therefore says nothing about tracking payments with merchants. Column 13, lines 3-12 is reproduced below:

Pursuant to some embodiments of the present invention, this ability to compare several partial shipments or authorizations with a single pre-authorization may be performed in a manner which is transparent to the purchasing client.

FIGS. 4 and 5 describe the databases **400** and **500** that may be maintained at (or otherwise accessible to) account management system **105** to track client information, associated limited use account identifiers, and transactions involving limited use account identifiers.

The passage refers to tracking client information, not tracking at least one merchant payment associated with the payment number; and associating the payment number and the claim identifier with the at least one merchant payment as recited in the claim. Claim 9 would be allowable as a matter of law as being dependent upon an allowable claim; namely claims 1 and 8. In light of the foregoing it is respectfully submitted that Wells fails to teach each element of the claim under consideration.

In response to this, the Office has referenced col. 24, lines 11-22 of Wells as follows:

In some embodiments, reversals or credits may also be tracked using features of the present invention. For example, *if a merchant credits an account* (e.g., for a returned item or the like), account management system 105 may operate to search for transactions associated with the limited use account identifier, the settled amount and/or with the merchant which are equivalent or near the amount of the credit. Once the original transaction is identified, *the credit amount* is associated with the original purchase order number and settlement *details are provided to the client*. In this manner, *the client's accounting and/or purchasing systems can track purchases as well as returns or credits*. (emphasis added)

However, the claim recites “tracking at least one merchant payment...” This is tracking a credit, not the payment as specified in the claims. Furthermore, it is occurring on the client. There can be no basis for saying the steps of the claims of the instant application involve tracking by the client/claimant.

As with claim 6, the Office has not addressed the following traversals from the prior Amendment A in the Office Action dated July 25, 2008. Therefore these traversals are repeated below:

Claim 10:

Claim 10 recites:

The method of claim 1, further comprising:

requesting a load of funds equal to the predetermined limit amount;

executing the load of funds;

generating a confirmation of the load of funds execution; and

reconciling the payment number and the claim identifier with the confirmation of the load of funds execution.

A step in claim 10 recites “requesting a load of funds *equal to* the predetermined limit amount ...” (emphasis added)

With respect to claim 10 the Office states: “Re claim 10. Wells further discloses the method of claim 1, further comprising: requesting a load of funds equal to the predetermined limit amount; executing the load of funds; generating a confirmation of the load of funds execution; and reconciling the payment number and the claim identifier with the confirmation of the load of funds execution (see fig.7 element 722).” Step 722 is a decision box that asks if the amount requested is below the preauthorization amount or threshold. A request is not being made for “a load of funds *equal to* the predetermined limit amount ...” as recited in the claim. See also column 20, lines 60-65 where it is stated “If processing at 722 indicates that the settlement amount requested by the merchant is not less than the pre-authorized amount (or is not less than the pre-authorized amount less a threshold amount), processing ends and the limited use account identifier is made available for future transactions in the card pool.” Thus, there is no request for a load of funds equal to the predetermined limit amount. In light of the foregoing it is respectfully submitted that Wells fails to teach each element of the claim under consideration.

Claims 13-14:

Claims 13-14 recite the limitation that the claim is an insurance claim and a warranty claim, respectively. The Office has rejected these claims with reference to column 3, lines 35-55.⁴⁵ Applicant can find no indication of the subject matter claimed in the cited section.

For the foregoing reasons it is respectfully submitted that Wells does not teach a methodologies as claimed in the instant invention. It is therefore respectfully requested that the Office withdraw the rejection of claims 1-17 under 35 U.S.C § 102(e).

Conclusion

For the reasons cited above, Applicant believes that claims 1 through 21, as amended, are patentable and in condition for allowance.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8525 is requested.

Very respectfully,
SMITH & HOPEN, P.A.

Dated: October 7, 2008

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⁴⁵ Office Action mail dated March 13, 2008 at page 4, first paragraph.

CERTIFICATE OF ELECTRONIC TRANSMISSION

(37 C.F.R. 2.190 (b))

I HEREBY CERTIFY that this correspondence is being electronically transmitted to the Patent and Trademark Office through EFS Web on October 7, 2008.

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Jessica Powell